

REMARKS

In the January 11, 2007 Office Action the Examiner required restriction to one of the sequences (SEQ ID NOS:1-29) as listed in claims 7, 8, 19-21, 40, 61, 62, 73-75, and 96.

In response to this restriction requirement, Applicants elect amino acid sequence DQYYLRVTTVA which is SEQ ID NO. 18 with traverse.

The Examiner's stated restriction is legally improper. As stated by the CCPA

As a general proposition, an applicant has a right to have *each claim* examined on the merits. *In Re Weber, Soder and Boksay* 198 USPQ 328, 331-332 (CCPA 1978)

Independent claims 1, 34, 55, and 90 are generic/linking claims. By requiring restriction as described above, the Examiner improperly requires that a single claim (*e.g.*, generic/linking claims 1, 34, 55, and 90) be divided up and presented in at least 29 different applications. This flatly contravenes accepted law:

If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

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§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions, It does not provide a basis under the authority of the Commissioner to *reject a particular claim* on that same basis.

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We hold that a rejection under §121 violates the basic right of the applicant to claim his invention as he chooses. *In Re Weber, Soder and Boksay* 198 USPQ 328, 331-332 (CCPA 1978)

See also, *In Re Haas* 179 USPQ 623, 624, 625 (*In Re Haas I*) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*).

The CCPA thus recognized that an Examiner **may not** reject a particular claim on the basis that it represents “independent and distinct” inventions. See, *In re Weber Soder and Boksay*, *supra*. Moreover, **the CCPA recognized that imposition of a restriction requirement on a single claim is just such an improper rejection.**

In particular, the courts have definitively ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. §121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. See, *In re Weber, Soder and Boksay, In Re Haas I, and In Re Haas II*. More specifically, the CCPA expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- **no matter how broad, which means no matter how many independently patentable inventions may fall within it.** [emphasis added] *In Re Weber* at 334.

Applicants recognize that instead of improperly imposing a restriction requirement on a single claim, the Office may limit initial examination to a “reasonable number” of species encompassed by the claim. See, 37 C.F.R. §1.146. This practice strikes an appropriate balance between the concerns of the patent office regarding administrative concerns and unduly burdensome examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated, provided the dictates of 35 U.S.C. §112 are complied with. See, *e.g.*, the MPEP at 803.02, *In Re Wolfrum* 179 USPQ 620 (CCPA, 1973) and *In re Kuehl* 177 USPQ 250 (CCPA, 1973).

Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to file multiple divisional applications that are incapable of capturing the intended scope of the application.

Finally, Applicants note that the CCPA has explicitly held that improper restriction of a single claim is a decision under the jurisdiction of the Board of Appeals, and the Federal Courts. This is in contrast to simple administrative decisions regarding ordinary restriction requirements,

which are not generally subject to Appellate review. *See, In Re Haas I, supra.* Because restriction of a single claim into multiple groups is tantamount to a rejection and a refusal to examine the claim as drafted, as articulated in *Haas I*, the Board of Appeals and the courts have jurisdiction over the decision. Accordingly, **Applicants expressly reserve the right to appeal any decision that may be made regarding the present response to the Patent Office Board of Appeals and to the Federal Circuit.**

In view of the foregoing, Applicants respectfully request that the restriction be made an election of species and that the linking claims be examined on their merits as drafted.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 267-4161.

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Respectfully submitted,

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